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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,685	05/03/2001	Jens Hamann	A34189 (071308.0149)	7455
7590	04/28/2004		EXAMINER	
Andreas Grubert BAKER BOTTS LLP ONE SHELL PLAZA 910 LOUISIANA STREET HOUSTON, TX 77002-4995			MACKEY, JAMES P	
			ART UNIT	PAPER NUMBER
			1722	
DATE MAILED: 04/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/848,685	HAMANN, JENS
	Examiner	Art Unit
	James Mackey	1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 March 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 2-5,8 and 10-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2-5,8 and 10-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 November 2003 and 20 January 2004 has been entered.

2. The drawings are objected to because Figure 1 is not labeled as "Fig. 1". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-5, 8 and 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original specification does not describe the piezoelectric actuators being located between the stationary carrier plate and the closure plate, as is currently claimed in claim 12 at lines 7-8.

5. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 11 only describes how the previously recited structural elements function; such relates only to the intended use of the claimed apparatus structure, which does not patentably distinguish the apparatus structure and therefore does not further limit the subject matter of the apparatus claims. See *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-5, 8 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, line 2, "piezoelectric means" (also in claim 11) is indefinite as to exactly how such means relates to and cooperates with the piezoelectric actuators of claim 12.

The term "briefly" in claim 11 is a relative term which renders the claim indefinite. The term "briefly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Note that when a term of degree is used in a claim, the specification must provide some standard for measuring that degree, since without proper definitional guidelines in the specification, a skilled artisan could not determine the metes and bounds of the claimed invention; see *Seattle Box Co., Ltd. v. Industrial Crating & Packing, Inc.*, 221 USPQ 568, 574.

In claim 12, line 4, “opposite towards” is unclear as to exactly what is intended and indefinite as to whether the closure plate is on the side of the clamping plate facing towards the carrier plate, or whether the closure plate is on the side of the clamping plate opposite to the side facing the carrier plate (note that claim 12 recites at lines 5-6 that pressing material or tools “are arranged between the clamping plate and the carrier plate”, which apparently indicates that no other plate may be arranged therebetween; however, **if** the claimed closure plate correspond to the “closing platen SP” as described in the specification, such a closure plate **is** located between the carrier platen TP and the clamping platen AP); clarification and correction is required.

Further in claim 12, lines 7-9, “located at a position selected from the group consisting of the carrier plate and the closure plate and between the closure plate and the clamping plate” is unclear (“located at a position … the carrier plate and the closure plate” should be --located at a position … **between** the carrier plate and the closure plate--), and is indefinite as to how actuators between the stationary carrier plate and the closure plate may trigger a force to disengage the clamping plate as recited at lines 6-7.

Also in claim 12, lines 10-11, “the carrier plate can be guided and subsequently fixed” is indefinite as to how the **stationary** carrier plate can move (it appears that the phrase should read --the clamping plate can be guided and subsequently fixed--).

In claim 15, “the piezoelectric actuators are in the shape of a rectangle” is indefinite as to whether each individual actuator has this shape, or whether this is the shape of the geometric distribution pattern defined in claim 8.

8. Claims 2-5, 8, 10 and 12-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James Mackey  
Primary Examiner  
Art Unit 1722

jpm  
April 27, 2004

4/27/04